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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,998	04/02/2001	Richard Gilles	ESSR:039US	1742

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EXAMINER

ZALUKAEVA, TATYANA

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 10/24/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Applicant No.	Applicant(s)
	09/824,998	GILLES ET AL.
	Examiner Tatyana Zalukaeva	Art Unit 1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 27 September 2002.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-27 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-27 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5</u> . | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 4 and 5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was treated as made without traverse in Paper No. 9, since Applicants did not point out otherwise.

2. Applicant's election without traverse of species of monomer (II) as per claim 6 and a monomer of formula (A1), as per claim 14 in Paper No. 9 is acknowledged.

Although, the species named by Applicants are not A SINGLE DISCLOSED SPECIE, Examiner examined the presented claims based on direction given by Applicants in their election and on the Examples of the instant Specification. The best way to elect a single disclosed specie in the instant case is to identify an Example from the Specification, which collectively exemplifies the elected species. At this time the Examination on the merits has been done, however, Examiner reserves the right to impose another election of species requirement, if Applicants further amend the claims.

3. Claims 1-27 are pending I the Application.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The transitional word (i.e. between the preamble and the body of claim) "characterized" and phrases incorporating it are common in applications of European origin. IN U.S. practice claims containing those words and phrases are rejectable under 35 USC 112.2 when characterization may connote more than mere description (dictionary definition); in scientific parlance characterization may imply one or more physical steps or procedures (e.g. structure determination, elemental analysis, or qualitative tests) to identify a product. Since it is rare that applicant intends more than a mere description when using this language, physical steps are rarely disclosed. As such the reader may be unsure about the meaning of the wording of the claims, and additionally the scope of the claim is often unclear ("characterized conveys no degree of openness"). Usually these troublesome words or phrases can be replaced by the standard transitional words, "having", "comprising", "wherein" and the like.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 12, 13, 16-24, are rejected under 35 U.S.C. 102(b) as being anticipated by Fukushima et al (U.S. 5,183,870).

The disclosure of Fukushima reads on the instant claims as follows:

Fukushima discloses a polymerizable composition comprising

(A) 10 to 60 parts by weight of a polybutylene glycol di(meth)acrylate represented by the general formula (I): (abstract)



(B) 20 to 80 parts by weight of a specific urethane poly(meth)acrylate or epoxy poly(meth)acrylate,

(C) 5 to 60 parts by weight of a specific mono(meth)acrylate, presented by the structures (II)-(V) in a paragraph bridging columns 2 and 3. and

(D) 0 to 60 parts by weight of a compound having at least one polymerizable double bond in the molecule, wherein the total amount of (A), (B), (C), and (D) being 100 parts by weight. (abstract).

The compound (B) constituting the second component is used to improve the thermal resistance of the resulting lenses, because lenses formed by using only the polybutylene di(meth)acrylate (A) constituting the first component will fail to have satisfactory thermal resistance (column 4, lines 12-17).

Useful urethane poly(meth)acrylates having two or more (meth)acryloyloxy groups in the molecule, which can be used as the compound (B), include products obtained by the urethane-forming reaction of a (meth)acrylate containing a hydroxyl group with a polyisocyanate having two or more isocyanate groups in the molecule (col. 4, lines 18-25). Suitable methacrylates and isocyanates are presented in col. 4, lines 26-55. These monomers are readable on the monomers (II) of the instant claims. With regard to component (C) of Fukushima, the specific examples of these compounds are presented in columns 7, 8 and 9 up to line 50. Examples of component (D) are presented in col. 11, lines 27-33.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

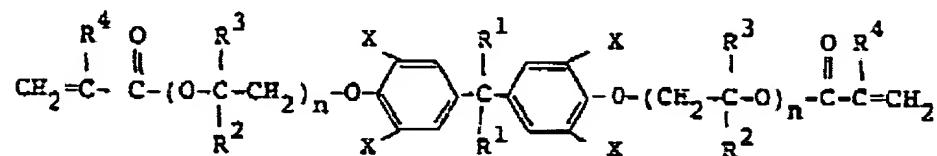
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 0 453 149.

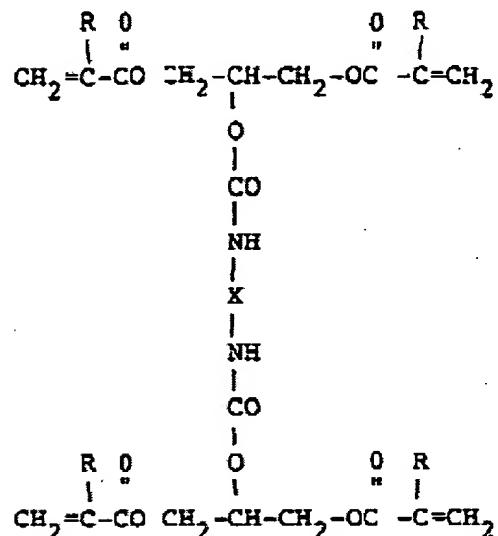
EP'149 discloses a crosslinkable polymeric casting composition comprising  
(A) polyoxyalkylene glycol diacrylate or dimethacrylate  
(B) a monomer having recurring unit derived from radical polymerizable bisphenol capable of forming polymer with refractive index more than 1.55;

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(C) a urethane monomer having 2-6 terminal groups comprising acrylic and methacrylic groups (abstract). The generic formula of a bisphenol component is presented on page 3, lines 15-25



The preferable urethane monomer is presented on page 5, lines 1-20:



Conventional photoinitiators and UV absorbers are used and discussed on page 6, lines 35-58. Table 1 presents different compositions of comonomers and their ratios in a composition, which are within the generic teaching of the instant claims.

These rejections is made under § 102 (b) in the sense of In re Shaumann, 572 F.2d 312, 197 USPQ 5 (CCPA 1978) (disclosure of a small genus enables a species), since EP'149 teaches a small genus which places a claimed species in the possession of the

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public, In re Schaumann, 197 USPQ 5, and the species would be obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. Alternatively, the disclosure and claims provide the person of ordinary skill in the art with the motivation and a reasonable expectation of success to make and use the suggested composition employing the generically disclosed monomers of the instant claims, the above render instant claims obvious.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Lim et al (U.S. 5,880,171) discloses fast curing polymerizable compositions for ophthalmic lens comprising urethane, epoxy, or polyester end terminated with acrylate or methacrylate; Toh (U.S. 4,912,185) discloses crosslinkable composition including at least polyoxyalkylene glycol giacrylate or dimethacrylate; Sitoh et al (U.S. 5,566,027) discloses a photocurable composition comprising polyfunctional urethane methacrylate.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tatyana Zalukaeva whose telephone number is (703) 308-8819. The examiner can normally be reached on 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703) 308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

TATYANA ZALUKAEVA  
PATENT EXAMINER



October 10, 2002

Tatyana Zalukaeva  
Examiner  
Art Unit 1713